

## REMARKS

### STATUS OF THE CLAIMS

In accordance with the foregoing, claims 1-8 have been amended. New claim 9 has been added. Claims 1-8 are pending and under consideration.

No new matter is being presented, and approval of the amended claims is respectfully requested.

### REJECTION OF CLAIM 5 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

On page 2, item 3, of the Office Action, the Examiner rejects claim 5 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Claim 5 is amended herein to distinctly claim the subject matter of the invention. Therefore, it is respectfully submitted that the rejection is overcome and should be withdrawn.

### REJECTIONS OF CLAIMS 1-8 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY PACE ET AL. (U.S. PATENT NO. 6,460,050)

The rejections of claims 1-8 are respectfully traversed and reconsideration is requested.

On Page 3, item 5, the Examiner rejects claim 1, stating that Pace et al. teaches sending a warning notice to the transmitter, when the recipient determines that the received electronic mail is junk mail and sends a reception refusal notice, citing column 4, lines 40-45.

The Examiner further states that Pace et al. teaches issuing a penalty invoice notice to the transmitter, when the recipient sends the reception refusal notice for a particular number of times with respect to the same transmitter, citing column 4, lines 45-53.

In fact, Pace et al. teaches, at column 4, lines 40-45, "the reply of the second tier system to the first tier system may be, for example, a refusal of service from the second tier system 30 to the first tier system 20 in cases where the first tier system is not authorized to make such requests." Pace et al. also states, "revenue may be generated in accordance with the present invention by providing the filtering service (i.e. running the second tier service process and maintaining the second tier database) for a fee *based on volume or other revenue criteria*. In this commercial context, the reply may be a refusal of service of the user of the first tier system 20 which has exceeded their allotted filtering quota for a given period." (Column 4, lines 45-53,

emphasis added).

In contrast, amended claim 1, recites "sending a warning notice to the transmitter, when the recipient determines that the received electronic mail is junk mail and sends a reception refusal notice; and issuing a penalty invoice notice *to the transmitter*, when the recipient sends the reception refusal notice to the same transmitter a particular number of times." (Emphasis added).

Therefore, it is respectfully submitted that claim 1 patentably distinguishes over the reference.

Claims 2-5 depend from claim 1 and inherit its patentable recitations. Therefore, it is respectfully submitted that claims 2-5 patentably distinguish over the reference.

On page 4 of the Office Action, the Examiner rejects claims 6-8, stating that they "include limitations that are substantially similar to claim 1 and are therefore rejected under the same art as claim 1 as being substantially similar."

Claims 6-8 recite sending a warning notice to the transmitter, when the recipient determines that the received electronic mail is junk mail and sends a reception refusal notice; and issuing a penalty invoice notice *to the transmitter*, when the recipient sends the reception refusal notice to the same transmitter a particular number of times. As argued above for claim 1, Pace et al. does not teach or suggest these features.

Therefore, it is respectfully submitted that claims 6-8 patentably distinguish over the reference.

#### NEW INDEPENDENT CLAIM 9

New claims 9 recites "sending a warning notice to the transmitter, when the recipient determines that the received electronic mail is junk mail and sends a reception refusal notice; and issuing a penalty invoice notice with respect to the electronic address of the transmitter, when the recipient sends the reception refusal notice to the same transmitter a particular number of times with respect to the same transmitter."

As asserted above for independent claim 1, Pace et al. does not teach or suggest these features. Therefore, it is respectfully submitted that claim 9 patentably distinguishes over the reference.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date:

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